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Ms. Alissa J. Tompkins  
Patent Examiner  
Art Unit 3765  
Alexandria, VA 22313-1450

Re: Application Number 10/827,208

Dear Ms. Tompkins:

I am writing in response to the recent Office communication concerning the above application papers dated 10/05/2005. Responses and corresponding corrections have been made as shown below.

**Response to additional references of prior art:**

Four additional references are added to the reference list and the differences between the added references and the current application are also addressed in the BACKGROUND OF THE INVENTION section (see corrections 1 to 3 for details).

**Correction 1:**

Add following 4 references as cited from the communication from your office dated Oct. 5, 2005, with minor typographical corrections for the original list.

<u>5896584</u>	Apr., 1999	Hauser
<u>6105162</u>	Aug., 2000	Douglas et al.
<u>5285529</u>	Feb., 1994	Arena
<u>6052827</u>	Apr., 2000	Widdemer

**Correction 2:**

Insert 2 additional references, as shown below, after Terris et al. 6,708346 B2 of line 5 in the second paragraph of BACKGROUND OF THE INVENTION section on page 2.

Arena 5,285,529, and Widdemer 6,052,827.

### **Correction 3:**

Add 2 additional references and address the differences, as shown below, at the end of the second paragraph of BACKGROUND OF THE INVENTION section on page 2.

The modifications of a sport glove with removable pad have also been attempted in the past and can be found in prior art patent disclosures shown in U.S. Pat. Hauser 5,896,584 and Douglas et al. 6,105,162. Hauser's patent claims that the removable pad is compressible with convex in shape to be used at the palm area. While Douglas et al. patent claims that the removable cushioning pad is also convex in shape but to be used to the back surface of the glove. Clearly, they are very different from golf glove saving pads of the present invention since the replaceable saving pad of the current invention is non-compressible and is uniform in shape not convex.

### **Response to the rejection of claim 4:**

The claim is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. It is a deficiency of the current application and will be corrected as an independent claim (see correction 4 for details).

### **Correction 4:**

Remove claim 4 from the original claim list. Combine old claim 4 with claim 2 and form a new independent claim 12 (see response regarding claim 2 rejection later).

### **Response to the rejections of claims 1, 3, 5-6, 9-12, 14, and 20-21:**

Claims are rejected under 35 U.S.C. 102(b) as being anticipated by Hauser (U.S. 5,896,584). It seems to be some similarity between the current application and Hauser's U.S. Pat No. 5,896,584. However, it is evident that there are two critical differences between them. For instance, claim 1 of Hauser's patent emphasizes and starts with "A **compressible** pad ....." while the glove saving pad of the current application is **non-compressible**. The same claim of **compressible** appears in Hauser's claims 1 to 14 and 19 (Note: 14 to 20 are related). Moreover, Hauser emphasizes his **compressible** pad has a **convex** surface which is another critical difference between his patent and the current application since the glove saving pad of the current application has **no convex** surface but rather is **uniform in thickness**. The convex surface claim in Hauser's patent can be found also in his claims 1, 2, 10, 11, 14, and 16. Among those, claims 1, 10, and 14 are 3 main (independent) claims of Hauser's patent. It can be concluded that the spirit and

scope of Hauser's patent emphasize that the pad of their patent is **compressible** and has a **convex** surface that are completely different from the glove saving pad of the current application since the glove saving pad of the current application are **non-compressible** and is **uniform in thickness** . The differences will be addressed and emphasized in the following corrections (see corrections 5 to 7 for details, in addition to correction 3).

#### **Correction 5:**

Since the replaceable saving pad of the current invention is not compressible, remove foam as one of the material example from following lines, along with removal of claim 13 from the original claims, to eliminate unnecessary confusion.

Line 5 of the first paragraph of DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

Line 10 of the third paragraph of DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

#### **Correction 6:**

Add following to the end of claim 1 to be more specific to differentiate the golf saving pad of the current invention from Hauser's claim in U.S. 5,896,584 which specifies the removable pad being **compressible** and **convex** in shape.

to form final non-compressible golf saving pad having uniform thickness.

#### **Correction 7:**

Remove old claims 20 and 21.

#### **Response to the rejections of claims 7-8, 13, and 15-19:**

Claims are rejected under 35 U.S.C. 102(b) as being anticipated by Douglas et al. (U.S. 6,105,162). It seems to be some similarity between the current application and Douglas et al. U.S. Pat No. 6,105,162. However, it is evident that there are critical differences between them. Douglas et al. emphasize, through out their claims of patent, that their cushioning pad is designed to be used at the **back surface** of the glove which is different from the intent of the current application. The glove saving pad of the current application is designed to be used at the **palm area** of the glove. It is understood that Douglas et. al. cushioning pads are removable and replaceable. However, Douglas et. al. also show " Preferably, the releasable connections between the cushioning pad and the **back surface** of the glove.....are provided by mating **thistle cloth connectors**, such as those available under the designation of **Velcro**." (column 2, 33-38) which is also known as a hook and loop fastening material (claims 10, 12, and 15). The current application shows no intent to use the material such as Velcro instead specifically indicates that **glue or**

**glue tape** is used to secure the removable and replaceable glove saving pad to the palm area of the glove. Another critical difference is that the outer surface of cushioning pad in Douglas et. al patent has a **convex curvature** which is different from the saving pad of the current application. The glove saving pad of the current application has **no convex** surface but rather is **uniform in thickness**. It can be concluded that the spirit and scope of Douglas et. al patent emphasize that the cushioning pad of their patent intended to be attached to the **back surface** of the glove using material such as **Velcro** and has **convex** outer surface that are completely different from the glove saving pad of the current application since the glove saving pad of the current application is designed to be used at **palm** area of the glove and is **uniform in thickness**. The differences were addressed and emphasized in **Correction 3** as shown above. Moreover, **Correction 6**, as shown above, should provide sufficient limits to differentiate independent claim 1 of current application from Douglas patent claim, for claims 7 and 8 of current application. Claim 13 is removed from the claim list (see correction 5). Regarding rejection of claims 15 to 19, see following corrections (corrections 8 and 9 for details).

**Correction 8:**

Integrate old claims 18 and 19 into old independent claim 15 to form a new independent claim 21. Meanwhile, specify the glove saving pad of the current invention being non-compressible and uniform in thickness to differentiate it from Douglas claim in U.S. 6,105,162 which specifies the pad convex in shape to be used for the back side of the sport glove.

**Correction 9:**

Due to the above changes, old claims 16 and 17 become new claims 22 and 23 respectively.

**Response to the rejection of claim 2:**

The claim is rejected under 35 U.S.C. 103(a) as being un-patentable over Hauser (U.S. 5,896,584). It has been presented in the response shown above that Hauser's patent and the current application have critical differences in the spirit and scope. In order to address and emphasize the difference, combine claim 2 with claim 4 to form an independent claim 12 in the new claim list (see corrections 10 to 12 for details).

**Correction 10:**

Remove claim 2 from the original claim list.

**Correction 11:**

Due to the removal of old claims 2, 4 and 13, old dependent claim numbers of independent claim 1 are all moved up accordingly and they become new claims 2 to 11 of the new claim list.

**Correction 12:**

Combine old claims 2 and 4 into a new independent claim 12 as shown below and its corresponding dependent claims 13 to 20 are added accordingly to the new claim list.

12. A removable and replaceable golf glove saving pad to be used and attached to a golf glove comprising:

at least one layer;

a double sided glue tape sealingly bonded to the bottom of the layer or a layer of releasable glue applied to the bottom of the layer to form final non-compressible golf saving pad having uniform thickness.

It should be noted that the addition of **non-compressible** golf saving pad having **uniform thickness** at the end of claim 12 should provide sufficient limits to differentiate it from the Hauser's patent claim.

**Additional corrections:**

To be consistent with the claims, the word "sealingly" is added to DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT section as shown below.

after "They are" in line 3 of first paragraph

after "They are" in line 3 of third paragraph

after "invention, are" in line 4 of sixth paragraph

Attached are the corrected pages for the application. I would greatly appreciate it if you could update your records to reflect the corrections for the above patent.

Thank you for your assistance in this matter.

Yours truly,



Mr. Yung-lung Tseng  
Attachments